

### **III. REMARKS**

#### ***Claim Status***

Claims 1-4 and 14-16 are under consideration in the application. Claims 5-13 remain held withdrawn from consideration as being drawn to nonelected subject matter 37 CFR 1.142(b).

#### ***Claim Rejections - 35 USC § 102***

Claims 1-4 and 14-16 stand rejected under 35 U.S.C. 102(a) and/or (b) as being anticipated by Hashimoto et al. and Kotar-Jordan et al. for the reasons set forth in the previous Office action mailed on June 15, 2005.

Applicant notes that the Examiner has re-instated the rejections of claims as being anticipated by Hashimoto et al. and Kotar-Jordan et al. for the reasons set forth in the Office Action mailed on June 15, 2005, despite the withdrawal of the rejections under 35 U.S.C 102 and 103 in the Office Action dated March 16, 2006 following applicant's remarks in their response to the office action of June 15, 2005.

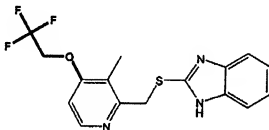
Applicants respectfully traverse this ground for rejection and respectfully disagree with the Examiner's understanding of the structures in question.

The Examiner states that Hashimoto et al. and Kotar-Jordan et al. specifically disclose the instant compounds. Note RN 103577-40-8 of Hashimoto et al. or page 289 of Kotar et al. and concludes that the instant compound is therefore anticipated by these references.

The Examiner then discusses polymorphism and argues that in the strictest sense, polymorphs are different crystalline forms of the same pure substance in which the molecules have different arrangements and/or different conformations of the molecules.

The Examiner notes the Declaration of Lobermann as being of little if any probative value.

The Examiner states that both Hashimoto et al. and Kotar-Jordan et al. disclose the specific compound 2-[[[3-methyl-4-(2,2,2-trifluoroethoxy)-2-pyridyl]methyl]thio]-benzimidazole of the following structure:

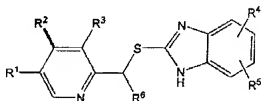


2-[[[3-methyl-4-(2,2,2-trifluoroethoxy)-2-pyridyl]methyl]thio]-1H-benzimidazole

K-1252 of Kotar-Jordan et al.

RN 103577-40-8 of Hashimoto et al.

However, this particular compound is not encompassed by the general formula (I) of the presently claimed compounds, because the substituent  $R^2$  cannot by definition represent a trifluoroalkoxy moiety:



$R^2$ , per claim 1, denotes hydrogen, a  $C_1$ - $C_8$  alkyl,  $C_3$ - $C_8$  cycloalkyl,  $C_2$ - $C_8$  fluoroalkyl or  $C_1$ - $C_8$  alkoxy moiety, in the compounds of general formula (I) of the present application.

In particular, the  $C_1$ - $C_8$  alkoxy moiety itself cannot be substituted with fluorine, so that the definition does not encompass the respective 2,2,2-trifluoroethoxy group that is present in K-1252 of Kotar-Jordan et al. and RN 103577 of Hashimoto et al.

The Examiner states that "a novel chemical product is identified by its 'chemical nature', i.e. elemental and atom content." (Office Action, page 3, lines 4-5). As just described, it has been shown beyond doubt that the compounds are different in their elemental and atom content, and consequently, the presently claimed invention is novel in view of the cited prior art.

The Examiner argues further that it is well-known that a substance can exist in different polymorphic forms and that polymorphs *are* different forms of the same pure substance (Office Action, page 3, lines 4-9).

However, the compounds of general formula (I) of the present application are different from the compound of Hashimoto et al. and Kotar-Jordan et al. Therefore, the crystalline forms of these distinct compounds cannot be regarded as polymorphic forms of each other.

Since the compounds are not the same and the crystalline phases of these structures are therefore not related as polymorphic forms, the Examiner's request for further X-ray crystal diffraction analyses of the compounds of the present invention *vis-a-vis* the prior art compounds is moot as being based on an incorrect interpretation of the underlying facts.

In this respect also, the Examiner's remarks concerning the changes in X-ray diffraction of powders would often result from experimental artifacts are not relevant in view of the facts presented.

Applicant believes the above depicted structures demonstrate beyond any doubt that the compounds are different and Applicant respectfully requests favorable reconsideration of the ground for rejection.

***Claim Rejections - 35 USC §103***

Claims 1-4 and 14-16 stand rejected under 35 U.S.C. 103(a) as being unpatentable over the combined teachings of Hashimoto et al. and Kotar-Jordan et al. in view of Brittain et al., Muzaffar et al, US Pharmacopia, and Concise Encyclopedia Chemistry.

This rejection is based on the incorrect understanding of the examiner that Hashimoto et al. and Kotar-Jordan et al. teach the crystalline forms of the claimed compounds (Office Action, page 4, third paragraph) and that the instant claims are drawn to the same pure substances as the prior art that only have different arrangements and/ or different conformations of the molecule (Office Action, page 5, lines 6-9).

Applicants respectfully disagree with the Examiner's position.

As set forth above, the compounds of Hashimoto et al. and Kotar-Jordan et al. are different from the compounds of the present application. The differences are not only in the arrangements and/ or conformations, but are indeed in the chemical structures *per se*. Therefore, the crystalline forms of these distinct compounds are also different.

Applicants do not comment on the proposition advanced by the Examiner that polymorphic forms of the same compound are obvious to one skilled in the art in view of the cited references (Brittain et al., Muzaffar et al.), as this proposition cannot apply to the compounds of the present application, because they are structurally different from the compounds known from the prior art.

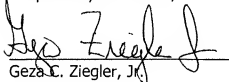
As set forth above, because the compounds from the prior art and those of the present application are different, there is no need to show that the polymorphic forms are different and the Examiner's request for prove that the properties of the compounds of general formula (I) are different from the prior-art compounds is without basis.

Applicant's position that it is unnecessary to prove any advantageous property in comparison to prior-art compounds because the presently claimed compounds are novel *per se* (Office Action, page 4, last paragraph).

Finally, as the Examiner has not continued the written description rejection of the last office action, applicants respectfully suggest that the present application now complies with all the requirements for patentability and pray for early allowance of all claims now pending.

The Commissioner is hereby authorized to charge payment of a two-month extension of time and any fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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2 July 2007  
Date

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